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EXAMINER

RIMELL, SAMUEL G

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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2175

DATE MAILED: 09/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/621,393

Applicant(s)

PORCARI, DAMIAN

Examiner

Sam Rimell

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

**SAM RIMELL**  
**PRIMARY EXAMINER**

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Examiner Handbook to the U.S. Patent Classification System, Revised February 1999, hereafter referred to as "Examiner Handbook". Only sections I-IV of the Examiner Handbook are reproduced since these are the only sections relevant to the present claims. The reproduced pages of the Examiner Handbook have been numbered by the Examiner in the lower right corner, and are referenced herein.

Claim 1: Page 5 first paragraph describes the United States Patent Classification System (USPC System) as establishing a plurality of classes. Source documents (patents) for each of the classes have been identified and placed into the classes (page 4, last four lines). A classification theme score in the form of a class number has been generated for each of the classes. For example, the class of business methods is associated with the class number 705, which reads as the theme score for that class. Unclassified documents, such as unexamined patent applications and allowed applications are entered into the classification process and assigned theme scores (class numbers) that correspond to their content (page 11, last two paragraphs). The unexamined application or allowed application is then classified into the class of the USPC System that matches the class assigned to the application.

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Claim 2: Page 5, paragraph 8 refers to a reclassification project, which is the identification of misclassified documents and assigning either a new class, new subclass, or both to the document.

Claim 3: The classification of the unclassified document is based upon a weighting process (pages 12-15, sections 1-6).

Claim 4: Patents inherently include predetermined sections, such as an abstract, an international classification and a USPC classification.

Claim 5: Classes in the USPC System are broken down into subclasses (page 5, line 2). Each class has multiple subclasses.

Claim 6: Both classes and subclasses are established by identifying and considering the informational content of documents (page 11, lines 2-3).

Claim 7: Page 5, paragraph 8 refers to a reclassification project. During such projects new classes and subclasses may be established. Source documents (sets of patents) are identified for each of the new classes. New class and subclass numbers are then assigned to each source document. The source documents are then placed into the new class and subclass number which exactly matches the class and subclass number assigned to the source document.

Claim 8: See remarks for claim 1. Note that classes are also associated with subclasses (page 5, line 2).

Claim 9: See remarks for claim 2.

Claim 10: See remarks for claim 3.

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Claim 11: The weighting process includes consideration of the claims in particular (pages 12-15). In a reclassification project, the original classifications or international classifications can be considered.

Claim 12: See remarks for claim 7.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 13-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Examiner Handbook .

Claim 13: The Examiner Handbook discloses each of the programmed functions associated with the controller, but does not disclose a conventional computer (input, memory, controller) to perform those functions. However, the usage of a computer to perform what are otherwise manual functions known in the prior art does not create a distinction over the prior art and is considered to have been obvious to one of ordinary skill in the art (*In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958); MPEP 2144, Section III).

Claim 14-15: Data input mechanisms such as the Internet and scanners are very well known in the art. It would have been obvious to one of ordinary skill in the art to deploy the Internet or document scanners for input mechanisms as a choice of design.

Claim 16: See remarks for claim 7.

Claim 17: See remarks for claim 3.

Claim 18: See remarks for claim 5.

Remarks

Applicant's arguments have been considered.

Applicant argues that the underlying emphasis of the invention is on the automation of the classification process. However, claims 1-12 make no mention of automation or of automation equipment used for automation. Claims 13-18 do make mention of the usage of automation equipment, but finds that the usage of such equipment would have been obvious. Examiner's position on this issue is set forth in detail in the discussion of claim 13 above, and includes the rationale, case law and MPEP citations in support of this rationale.

Applicant argues that the USPC document does not disclose theme scores which are based upon the content of source documents. This argument is not correct. As set forth in the detailed explanation associated with claim 1, the USPC classification system sets forth a series of classes and assigns a theme score to each class. The theme score is the class number for that class. The theme scores are based upon content of patent documents that are found to be classifiable in that class. For example, class 705 was established as a class for patents known to contain subject matter related to business methods. Class 705 is thus an example of a theme score. As seen in the last four lines of page 4, the classes are established based upon a consideration of existing US patents. Thus, the class number (theme score) is based upon the content of existing source documents.

Applicant further argues that the USPC document does not disclose the step of classifying unclassified documents when an unclassified document theme score is equal to a classification theme score. However, this feature was described in detail in the discussion of

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claim 1 above. Examiner maintains that these steps are in fact described in the USPC document and are discussed in the detailed discussion associated with claim 1.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication should be directed to Sam Rimell at telephone number (703) 306-5626.



Sam Rimell  
Primary Examiner  
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